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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Sigfried GAHLER, et al.	]	Confirm No.: 6469
Serial No.: 10/528,301	]	GRP. ART UNIT: 1793
Filed: March 17, 2005	]	Ex.: BRUNSMAN, D. M
For: COATING COMPOSITION, PARTICULARLY FOR GLASS SURFACES, AND METHODS FOR THE PRODUCTION AND USE THEREOF	]	

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Vangelis Economou, Reg. No. 32,341

Mail Stop Amendment
Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO RESRICTION REQUIREMENT

Sir:

In response to the restriction requirement in the Office Action dated June 23, 2008, Applicant herewith traverses the restriction requirement and further makes the required provisional election.

Traversal of Requirement

The restriction is improper in that it fails to show evidence that the alleged two inventions, as listed in Groups I and II, are independent and distinct. Initially it is noted that an improper standard has been applied in this respect to the claims of this invention. PCT Rule 13.1 is relied upon as the basis for lack of unity of invention, because allegedly the claims of Group I and II are asserted as not relating to a single general inventive concept.

It is respectfully suggested that the citation of PCT Rules against this U.S. Patent National Application is improper. As understood, the PCT Lack of Unity provisions apply only to International cases filed under the PCT. It is further noted that this National Phase Application was examined by the European Patent Office (EPO) under the PCT, in PCT Application No. PCT/2003/11817 (publication No. WO 2004/039740), a copy of which was submitted with the originally filed application. No Lack of Unity requirement was issued against the PCT application during prosecution, as none was appropriate. Applicants rely on the finding of the EPO as a standard for application of the PCT rules foe finding the Lack of Unity Provisions inapposite to this application.

Moreover, the Examiner's characterization of the "same or corresponding special technical feature" residing in a "silver compound" is not agreed with. The fact that one feature out of the several elements in the composition recited by each of the claims, may be rejected by prior art does not render the sets of claims separate independent and distinct inventions as required by 35 U.S.C. § 121, 37 C.F.R. §1.141 et seq., MPEP §802.01, and the relevant case law.

In a recent Federal Circuit opinion, the basis was again set forth on which a restriction requirement is proper under U.S. Patent Laws and Regulations:

> "...The Patent Office can issue a restriction requirement if it finds that two or more inventions claimed in a patent application are "independent and distinct." 35 U.S.C.§ 121 (1994). A process and apparatus (tool) for its practice can be restricted if either "the process *as claimed* can be practiced by another materially different apparatus or by hand" or "the apparatus *as claimed* can be used to practice another and materially different process." Man. Pat. Examining Proc. § 806.05(e) (7th ed. 1998). In response to a restriction requirement, an applicant must elect one invention for examination. *See* 37 C.F.R. § 1.142(a) (1999). Claims to the non-elected invention(s) are withdrawn from consideration and must be canceled before the application is allowed to issue as a patent. *See* 37 C.F.R.§ 1.142(b) (1999)." Helifix Ltd. v. Blok-Lok Ltd., 1305 (Fed.Cir. 2000) 54 USPQ2d 1299, 1305. *See also*, Applied Materials Inc. v. Advanced Semiconductor Materials (Fed.Cir. 1996) 40 USPQ2d 1481.

The claims of the present application in Group I, Claims 1-11 and in Group III, Claims 19-20 are related not to a coating composition and a coating method, as asserted, but rather Group III Claims 19-20 are drawn to a "method of producing a coating composition." Since the method produces the composition, and the composition is produced by the method, the relation is clearly shown. As set forth in the Office Action, the restriction requirement is improper because the application claims have not been shown to be independent and distinct inventions, as required under US Patent laws and regulations, for example, 35 U.S.C. § 121, 37 C.F.R. §1.141 et seq.

Thus, it is respectfully suggested that an improper standard has been applied in this restriction requirement, and reconsideration and withdrawal of the requirement are respectfully requested.

Provisional Election

Subject to the above traverse, Applicant provisionally elects Group I, Claims 1-11, drawn to a coating composition for further prosecution.

Respectfully submitted,

Date: July 23, 2008

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